

REMARKS

Claims 43-51 and 55-69 were pending and under examination at the time of the Office Action. Claims 28-33 and 37-42 are withdrawn from consideration. Claims 43-51 and 55-69 are rejected under 35 U.S.C. § 101. Claims 47-51 and 58-63 are rejected under 35 U.S.C. § 112, first paragraph. Claims 57, 60, 63, and 69 are rejected under 35 U.S.C. § 112, second paragraph. Claims 43-44, 46, and 64-66 are rejected under 35 U.S.C. § 103(a). Applicants address these rejections below.

Claim Amendments

Claim 43 has been amended to incorporate each and every element of dependent claim 45. Claim 43 has further been amended to recite a computer within the body of the claim. Support for these amendments is found, e.g., on page 6, lines 4-10 and 16-17, of the specification as filed.

Claims 44-45, 47-51, and 58-63 have been cancelled.

Claim 55 has been amended to recite a computer program product including a computer-readable medium including a computer-readable program code embodied therein, the code adapted to be executed to implement the method as claimed in claim 43. Support is found, e.g., on page 6, lines 20-22, and page 30, lines 24-30, of the specification as filed.

Claim 57 has been amended to recite a method of transmitting a computer-readable

program code, the method including using a computer to transmit the computer-readable program code over a local or wide area telecommunications network, wherein the computer-readable program code is embodied in a computer-readable medium and is adapted to be executed to implement the method as claimed in claim 43. Support is found, e.g., on page 6, lines 20-24, and page 30, lines 24-30, of the specification as filed.

Claims 67 and 69 have been amended similarly to claims 55 and 57, respectively.

No new matter has been added by any of the aforementioned amendments.

Applicants reserve the right to pursue any cancelled subject matter in this or in a related application.

Rejections Under 35 U.S.C. § 101

Claims 43-51 and 64-66 are rejected under 35 U.S.C. § 101 as not falling within one of the four statutory categories of invention. The Office states (page 3): “To embody statutory subject matter, the computer should be recited in association with a step or steps meaningful to the claimed invention.”

Claim 43 has been amended to recite “using said computer” throughout the body of the claim. As discussed further below, claim 43, as amended, satisfies the statutory requirement of subject matter eligibility under 35 U.S.C. § 101. See Bilski v. Kappos, 561 U.S. ____ (2010), as well as the Office’s recent guidance on the subject, Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski

v. Kappos, 75 Fed. Reg. 43922 (July 27, 2010).

As the Supreme Court stated, “This Court’s precedents establish that the machine-or-transformation test is a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under §101.” Bilski at 8. In addition, the Interim Guidance provides three main factors weighing in favor of eligibility: 1) The claim recites a machine or transformation (either express or inherent); 2) The claim is directed toward applying a law of nature; and 3) The claim is more than a mere statement of a concept. Interim Guidance at 43927.

Claim 43, as amended, satisfies both the machine-or-transformation test discussed in Bilski and the first factor of the Interim Guidance, by, *inter alia*, expressly reciting a machine in the body of the claim. For example, claim 43, as amended, recites the phrase “using said computer” in the body of the claim in conjunction with each step of the claimed method. In addition, in accordance with the second factor of the Interim Guidance, the claim is directed toward an application rather than an abstract idea; the claimed method features the use of a computer to detect and/or extract anatomical features on surface measurements from a series of time-dependent images of a surface of body parts of a creature. No natural force, scientific fact, law of nature, or other abstract idea is monopolized or preempted by claim 43. Finally, in accordance with the third factor of the Interim Guidance, claim 43 amounts to more than a mere statement of a concept, as the claim recites a particular solution to a problem to be solved, in particular,

detection and/or extraction of anatomical features on surface measurements, as noted above. Therefore, claim 43, and dependent claims thereof, satisfy the requirements of 35 U.S.C. § 101 as elucidated by Supreme Court precedent and the Office's Interim Guidance. The rejection of claims 43, 46, and 64-66 should thus be withdrawn.

Claims 55-63 and 67-69 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office states (page 3): "A statutory product comprising function descriptive material must include a positive recitation of a computer readable medium – MPEP 2106.01." As suggested by the Office, claims 55-57 and 67-69 have been amended to include a positive recitation of a computer readable medium, or depend from a claim that has been so amended. For this reason, as well as the reasons discussed above in connection with claims 43, 46, and 64-66, the rejection of claims 55-57 and 67-69 under 35 U.S.C. § 101 should be withdrawn.

Claims 57, 60, 63, and 69 are rejected under 35 U.S.C. § 101 as being nonstatutory for encompassing transitory subject matter. Claims 60 and 63 have been cancelled. Claims 57 and 69 have been amended to recite a method of transmitting a computer-readable program code. As amended, claims 57 and 69 are each directed to a statutory class, namely, to a process. Furthermore, the claims require use of a computer and positively recite a computer-readable medium. Even assuming *arguendo* that transmission *per se* involves a degree of abstraction, claims 57 and 69, as amended, are not directed to transmission *per se* but rather to a method of transmitting a computer-

readable program code, wherein the claimed methods are firmly anchored in the real world by their use of a computer as well as by the embodiment of the computer-readable program code in a computer-readable medium. Applicants submit that claims are to be evaluated as a whole, Interim Guidance at 43925, and further note that “**the text of § 101 is expansive**, specifying four independent categories of inventions eligible for protection, **including processes...**” Interim Guidance at 43923 (emphasis added). For these reasons, as well as the reasons discussed above in connection with claims 43, 46, and 64-66, the rejection of claims 57 and 69 under 35 U.S.C. § 101 should be withdrawn.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 47-51 and 58-63 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Claims 47-51 and 58-63 have been cancelled. Accordingly, the rejection under 35 U.S.C. § 112, first paragraph, is moot.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 57, 60, 63, and 69 are rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Claims 60 and 63 have been cancelled. Claims 57 and 69, as amended, each recite “a method of transmitting a computer-readable program code.” These claims, as amended, are directed to the statutory class of processes; furthermore, it is apparent in each claim where the preamble ends and the body of the claim begins.

Accordingly, the rejection under 35 U.S.C. § 112, second paragraph, should be withdrawn.

Rejection Under 35 U.S.C. § 103(a)

Claims 43-44, 46, and 64-66 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Drerup et al., *Clin. Biomech.* 9:28-36, 1994, and Higaki, U.S. Patent Application Publication No. 2002-0031265. Claim 45 is free of this basis of rejection. Applicants have amended claim 43 to incorporate each and every element of dependent claim 45. All claims, as amended, depend from or otherwise require each and every element of claim 43, as amended. Accordingly, the rejection under 35 U.S.C. § 103(a) is moot.

CONCLUSION

Applicants submit that the claims are in condition for allowance, and such action is respectfully requested. Enclosed is a Petition to extend the period for replying to the Office Action for two months, to and including August 9, 2010, as August 8, 2010, is a Sunday.

If there are any additional charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,



James D. DeCamp, Ph.D.
Reg. No. 43,580 *MICHAEL A. ROBINSON, Ph.D.*
REG. NO. 57903

Date: AUGUST 9, 2010
Clark & Elbing LLP
101 Federal Street
Boston, MA 02110
Telephone: 617-428-0200
Facsimile: 617-428-7045